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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/911,718 | 07/25/2001 | Noriyuki Hori | Q65524 | 4071 |

7590 04/21/2005
SUGHRUE, MION, ZINN, MACPEAK & SEAS
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Washington, DC 20037

EXAMINER

TAYLOR, NICHOLAS R

ART UNIT PAPER NUMBER

2141

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|---------------------------------------|---------------------------------------|--|
| <p align="center">Office Action Summary</p> | Application No. 09/911,718 | Applicant(s) HORI, NORIYUKI | |
| | Examiner Nicholas R. Taylor | Art Unit 2141 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-19 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-19 and 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 1001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

1. Claims 1-35 have been presented for examination and are rejected.

Response to Arguments

2. Applicant's arguments filed 2/25/2005 have been fully considered but they are deemed not persuasive.

3. In the remarks, applicant argued in substance that:

(A) Prior art of CollegeView does not teach an electronic leaflet.

As to point (A), the Examiner disagrees with the Applicant's reading of the CollegeView teaching. CollegeView teaches university information stored in an "Online multimedia presentation" containing various types of media (CollegeView, page 4 paragraph 2.) Furthermore, CollegeView's university pages are visibly indexed in a centralized format with all pages shown in relation to each other (CollegeView, page 6.)

(B) Prior art of Beattie does not teach organizing information into a predetermined layered structure and storing the information in a database.

As to point (B), Beattie teaches text documents layered with image, audio or other multi-media information files stored in a library database (Beattie, column 9, 43-

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54.) See also Beattie figure 2, items 208 and 210. Beattie also teaches storing the information in the database (Beattie figure 1, item 112 and figure 3 item 112.)

(C) There is no motivation to combine CollegeView and Beattie, specifically through failure to avoid hindsight and unclear reasoning to combine.

As to point (C), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971.)

Furthermore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992.)

In this case, CollegeView provides functionality that when enhanced with the addition of the layered structure and information storage of Beattie would improve

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CollegeView's search/retrieval system. The desirability of this enhancement is specifically stated in the prior art (Beattie, column 1, lines 44-50) and is therefore an appropriate combination.

(D) Prior art of Beattie and Her-Hoyman fail to teach charging the user for accessing data.

As to point (D), Beattie teaches accounting and subscriber services (Beattie, column 11, lines 1-2) wherein new users are enrolled and user accesses to data are linked to the accounting database (Beattie, column 11, lines 7-15.) Beattie teaches that this accounting database stores royalty information (Beattie, column 9, line 65 to column 10, line 5) and the user's data accesses are tracked for purposes of fee calculation (Beattie, column 7, lines 5-10.)

(E) There is no motivation to combine CollegeView-Beattie and Fields, specifically through unclear reasoning to combine.

As to point (E), in view of the Examiner's recognition of combination requirements in point (C) above, the Examiner disagrees that there is a lack of motivation to combine Fields with the art taught by Beattie and Fields. Users of CollegeView's site are searching for a variety of university data that includes course information such as "fields of study (majors)" (CollegeView, page 4, paragraph 1.) One of ordinary skill in the art would acknowledge that further information concerning course

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selection, such as the customized data described in the prior art (Fields, column 1, lines 6-10), adds to and improves the information available to a user searching in this area.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-12, 18, 19, 21-29, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over CollegeView.com (<http://web.archive.org/web/19970116182733/http://www.collegeview.com/>), hereafter referred to as "CollegeView") and Beattie et al. (US Patent 5,659,742.)

6. As per claims 1 and 18, CollegeView teaches an electronic leaflet system comprising:

generating by a server an electronic leaflet by making contents data related to leaflets concerning a plurality of educational organizations into an electronic information through designation of various kinds of selection items set in a web site of the server; (CollegeView, page 6, sample leaflet for Acadia University, and page 5 for hyperlink selection items)

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selecting from the database at least one electronic leaflet optimum for various conditions presented by a user; transmitting by the server via an internet to the user the selected electronic leaflet; presenting the selected electronic leaflet on a client terminal to the user; and (CollegeView, page 2-4 for selection, page 6 for sample leaflet generation/presentation)

automatically reproducing on the client terminal the contents contained in a sub-menu prepared in advance in the selected electronic leaflet in response to a request from the user, wherein the sub-menu promotes understanding of the contents in the selected electronic leaflet, and (CollegeView, page 2-4 for selection, page 6 for sample leaflet generation/presentation)

at least one optimum electronic leaflet is selected from electronic leaflets according to various conditions provided by the user, where the user specifies the various conditions via selecting various kinds of items related to icons on the web site of said server (CollegeView, page 2-3.)

However, CollegeView fails to specifically teach organizing said generated electronic leaflet into a predetermined layered structure and storing said structured electronic leaflet in a database. Beattie teaches a database storing layered multimedia information made available for searching and retrieval (Beattie, column 8 line 60 to column 9 line 8.)

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined CollegeView and Beattie to provide a structured database and retrieval system of leaflets in the system of CollegeView, because doing

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so would enable desirable searching and retrieval of multimedia leaflet information (Beattie, column 1, lines 44-50.)

7. As per claims 2 and 19, CollegeView-Beattie teaches the system further wherein said electronic leaflet relates to at least one of lecture, school for attending-school education or correspondence course of a plurality of educational organizations (CollegeView, page 1 and page 4.)

8. As per claims 4 and 21, CollegeView-Beattie teaches the system further comprising:

when the user accesses the web site, checking user rights for access and when the user is authorized to access the website, informing the web site of said server that the client terminal of the user is allowed to access the web site of said server (Beattie, column 10 line 65 to column 11 line 15, and figures 3-4.)

9. As per claims 5 and 22, CollegeView-Beattie teaches the system further wherein said selection of the at least one optimum electronic leaflet further comprises:

receiving various conditions (CollegeView, page 2-3) presented by the authorized user (Beattie, column 10 line 65 to column 11 line 15) clicking an icon on the web site to designate each kind of selection items related to the icon in question, and (CollegeView, page 2-3)

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searching said electronic leaflet data base based on the received various conditions to select at least one electronic leaflet that most closely matched the various conditions input by the user and present, for the user, the selected electronic leaflet on said client terminal of the user (CollegeView, results of searches initiated from pages 2-3.)

10. As per claims 6 and 23, CollegeView-Beattie teaches the system further wherein said selection of the at least one optimum electronic leaflet comprises:

receiving through the internet various conditions (CollegeView, page 2-3) provided by the authorized user (Beattie, column 10 line 65 to column 11 line 15) by clicking an icon on the web site to designate each kind of selection items related to the icon (CollegeView, page 2-3),

searching said electronic leaflet data base based on the received various conditions to select a predetermined number of electronic leaflets in a descending order of suitability for the various conditions input by the user, and presenting the selected electronic leaflets to the client terminal of the user (CollegeView, results of searches initiated from pages 2-3.)

11. As per claims 7 and 24, CollegeView-Beattie teaches the system further wherein the automatic reproduction of the contents of the selected electronic leaflet in the sub-menu comprises: when the selected electronic leaflet contains as prepared contents at least one of moving picture data, voice data, and document data, automatically

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reproducing the contents on the display of the client terminal of the user facilitating understanding of the contents prepared in the selected electronic leaflet (CollegeView, page 6, wherein the school information is a reproduction of the original server's leaflet page.)

12. As per claims 8 and 25, CollegeView-Beattie teaches the system further wherein said at least one of moving picture data, voice data, and document data comprise data generated by editing scenes of recorded school lessons attended by students or online classes and lecture meetings held by the education organizations (CollegeView, page 4, wherein "multimedia presentations" are available for each school.)

13. As per claims 9 and 26, CollegeView-Beattie teaches the system further wherein said at least one of moving picture data, voice data, and document data comprise data generated by editing previously recorded interview scenes of lecturers in charge of attendance or online classes and lecture meetings held by educations organizations (CollegeView, page 4, wherein "multimedia presentations" are available for each school.)

14. As per claims 10 and 27, CollegeView-Beattie teaches the system further wherein said at least one of moving picture data, voice data, and document data comprise data generated by recording and editing interview scenes of students who previously took attended school or online classes and lecture meetings held by

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educational organizations (CollegeView, page 4, wherein “multimedia presentations” are available for each school.)

15. As per claims 11 and 28, CollegeView-Beattie teaches the system further wherein said at least one of moving picture data, voice data, and document data comprise data generated by editing teaching materials and transcripts of lectures presented in attending-school education correspondence courses of educational organizations (CollegeView, page 4, wherein “multimedia presentations” are available for each school.)

16. As per claims 12 and 29, CollegeView-Beattie teaches the system further wherein the various kinds of selection items designated by the user comprise a condition related to at least one of ability, qualification, budget, school lesson schedule and qualifying schedule for lecture in attending-school education or correspondence course of educational organizations (CollegeView, page 2-3, specifically where the Student Body Type field is a qualification.)

17. As per claim 35, CollegeView teaches the system further wherein the plurality of educational organizations comprise at least one of universities, preparatory schools, professional schools, cultural schools and private schools for elementary/junior high/high schools (CollegeView, page 1.)

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18. Claims 13 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over CollegeView.com (<http://web.archive.org/web/19970116182733/http://www.collegeview.com/>, hereafter referred to as "CollegeView") and Beattie et al. (US Patent 5,659,742), further in view of Fields et al. (US Patent 6,347,943.)

19. As per claims 13 and 30, CollegeView-Beattie teaches the above, yet fails to teach the mock examination system of claims 13 and 30.

Fields teaches a mock examination system comprising:

clicking by the authorized user a mock examination icon enabling selection of a mock examination for supporting self-determination of at least one of basic scholastic ability and aptitude, required for attending-school or online classes and lecture meetings held by educational organizations, (Fields, column 3, lines 46-59, specifically the "assessment mechanism" used in relation to a college course)

sending via the internet question data of the mock examination to the client terminal of the user; receiving answer data from the user to mark the answer data; (Fields, column 3, lines 46-59, specifically the "assessment mechanism" used in relation to a college course, and figure 8)

generating the various conditions, where the various conditions comprise current ability of the user, ability required for taking an online class or a lecture meeting, a kind of the online class or the lecture meeting recommended, and a specific name of the recommended online class or the recommended lecture meeting based on the marking result; and outputting the conditions to said automatic reproduction of the contents of

the electronic leaflet (Fields, column 3, lines 46-59, specifically the “customized learning pathway” previously authored by a course content author such as a college professor, and figure 8.)

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined CollegeView-Beattie and Fields to provide a mock examination method in the system of CollegeView-Beattie, because doing so would allow each user to select a customized course of instruction based on assessment of each user’s knowledgeability of a particular topic (Fields, column 1, lines 6-10.)

20. Claims 14-17 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over CollegeView.com (<http://web.archive.org/web/19970116182733/http://www.collegeview.com/>, hereafter referred to as “CollegeView”) and Beattie et al. (US Patent 5,659,742), further in view of Herr-Hoyman et al. (US Patent 5,727,156.)

21. As per claims 14 and 31, CollegeView-Beattie teaches the above, yet fails to teach the system further comprising charging the educational organization according to volume of data at new registration or updating of contents data of an electronic leaflet conducted during the generation of the leaflet.

Herr-Hoyman teaches charging according to the volume of data at a new registration in a system that stores information using a database (Herr-Hoyman, column 4, lines 9-17.) It would have been obvious to one of ordinary skill in the art, at the time

the invention was made, to have combined CollegeView-Beattie and Herr-Hoyman to provide charging at a new registration in the system of CollegeView-Beattie, because doing so would enable charging a fee from the user.

22. As per claims 15 and 32, CollegeView-Beattie-Herr-Hoyman teaches the system further wherein said charging the educational organization according to the volume of data at new registration or at updating of contents data of an electronic leaflet in said electronic leaflet data base (Herr-Hoyman, column 4, lines 9-17.)

23. As per claims 16 and 33, CollegeView-Beattie-Herr-Hoyman teaches the system further wherein:

when the user accesses the web site of said server, checking whether the user has a right to access the electronic leaflets, and if the user has a chargeable right to access, informing for said charging of the education organization and for said selection of the at least one optimum electronic leaflet that the user is allowed to access at least one of chargeable moving picture data, chargeable voice data, and chargeable document data; (Beattie, column 10 line 65 to column 11 line 15, and figures 3-4)

for said selection of the at least one optimum electronic leaflet, receiving said various conditions presented by the user, who is allowed to access the electronic leaflets, where said conditions are selected by clicking the icon on the web site to designate said each kind of selection items related to the icon, and (CollegeView, results of searches initiated from pages 2-3)

searching said electronic leaflet data base based on the received various conditions to select a chargeable electronic leaflet, from the chargeable electronic leaflets accumulated in the electronic leaflet data base, that most closely matches the various conditions inputted by the user and (CollegeView, results of searches initiated from pages 2-3)

presenting the user with the selected electronic leaflet via said client terminal of the user, (CollegeView, page 6) and charging the user according to conditions of access to a chargeable electronic leaflet (Beattie, column 9, line 65 to column 10, line 5; column 7, lines 5-10; column 35, lines 37-41; and column 35, lines 59-67.)

24. As per claims 17 and 34, CollegeView-Beattie-Herr-Hoyman teaches the system further wherein when at least one moving picture data, voice data, and document data are sent via the internet to the user, the user is charged for the sent data (Beattie, column 9, line 65 to column 10, line 5; column 7, lines 5-10; column 35, lines 37-41; and column 35, lines 59-67.)

Conclusion

25. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Taylor
Examiner
Art Unit 2141


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER